REMARKS

Claims 1 through 17 and 19 through 31 are currently pending in the application. Claims 30 and 31 have been withdrawn from consideration. Claims 20 through 25, 28, and 29 have been allowed.

Claims 1 through 17 and 19 stand rejected under 35 U.S.C. §112 as allegedly failing to comply with the written description requirement. Claims 1 through 17, 19, 28, and 29 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. patent application Publication No. US 2002/0094885 (Finkel). Claims 26 and 27 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,315,683, to Yoshida et al (Yoshida).

Reconsideration of the rejection of claims 1 through 17, 19, 26, and 27 is requested.

Applicant's undersigned attorney wishes to thank Examiner Gorden for the courtesies extended him in the interview on March 8, 2005.

During the interview, the rejection of claims under 35 U.S.C. §112 was discussed. The Examiner alleges that the specification does not support the limitations that a difference between the first and second performance characteristics is detectable by striking the golf ball with a golf club. The Examiner suggested that the applicant identify specific portions of the specification that support these limitations.

On page 9, of the specification, in lines 11 through 13, it is stated: "Consequently, once the material melts to a significant degree, the golf ball 20 may not be practically usable to play golf with or will be noticeably compromised in terms of its performance."

As noted in the last three lines of applicant's specification, on page 12, the change in state "noticeably alter[s] the playing characteristics of the ball 160."

Inherently, the playing characteristics of the ball are detectable by reason of playing golf with the ball, which involves striking the ball with a golf club. This specific limitation has been added to the specification on page 12 to further clarify this concept.

In light of the fact that the invention is focused on the ability of the golfer to detect the change in state of the golf ball, in the event that the ball is struck with a golf club, this limitation in the claims is clearly supported by the original specification. In light of that, withdrawal of the rejection under 35 U.S.C. §112 with respect to this limitation is requested.

Each of claims 1 through 17 and 19 is directed to a golf ball that has a speeded degradation compared to conventional golf balls, but that is usable in a conventional manner even under wet conditions during a round of golf, or after continuous immersion for a period up to two days. The invention is focused on degradation that (1) is delayed so that performance characteristics of the ball will not be changed during a round of golf in wet conditions or upon being immersed for a short period (less than 2 days), and (2) occurs more rapidly than with a conventional golf ball.

The main objective of the present invention is to avoid recovery of golf balls that have been immersed in water for extended periods and resale of those golf balls. Immersion for relatively extended periods can cause a golf ball to lose "carry." Within a 180 day period of immersion, the loss of carry may be several yards but undetectable to an average golfer. Golf ball manufacturers are highly competitive and often promote as one of their main advantages, extra distance, even if it is only a few yards. Thus, golf

ball manufacturers do not wish to have in the market re-used golf balls carrying their company's identification that may have compromised performance characteristics, which reduce yardage only a handful of yards, even though this would not be detectable to the average golfer.

Finkel's golf ball is first of all directed to a "short-range practice golf ball" as described in the title and elsewhere throughout the written description therein. The golf ball is intended to "quickly" decompose. Finkel is not concerned with maintaining original performance characteristics by delaying degradation, as is the applicant.

The Examiner suggested during the interview that the Applicant point out parts of Finkel's disclosure wherein the quick deterioration is described. A number of those areas are described below.

In the Abstract, Finkel describes that "the golf ball material will quickly oxidize, degrade, disintegrate, melt or otherwise decompose to leave products harmless to, or beneficial to, the natural environment" (lines 4 through 7 of the Abstract-our emphasis).

In Finkel's paragraph [0055], it is stated, "Preferably, part or all of the golf ball is configured to decompose quickly upon exposure to water, sunlight, or air. For example, in one embodiment of the invention, the golf ball is configured to completely dissolve after being exposed to air, water, or sunlight (or any combination thereof) for a period of time that is three days or less." (lines 4 through 10-our emphasis).

It was pointed out during the interview that this language does not in any way convey that performance characteristics are maintained for any period of time - complete disappearance of the golf ball is contemplated in "three days or less". Finkel

contemplates that decomposition occurs "quickly," as a result of which performance characteristics are quickly changed.

In Finkel's paragraph [0078], a construction is described with a water-impermeable membrane 45 that surrounds a shell layer 44. Upon being struck, the water-impermeable membrane shatters to expose the shell layer which "immediately begins to decompose". (our emphasis)

As stated in Finkel's paragraph [0025] "the golf ball is preferably configured to begin dissolving upon contact with water."

As noted, Applicant does not intend that the golf ball begin dissolving upon contact with water, but rather that there be a delay which allows the golf ball to be used even under wet conditions, or upon being immersed continuously for a period of no less than 2 days.

Accordingly, none of claims 1 through 17 and 19 is taught or suggested by Finkel.

On page 3 of the Action, the Examiner identifies claims 28 and 29 as anticipated by Finkel. However, these claims are indicated to be allowed elsewhere in the Action. It is assumed that this rejection is improper and thus it will not be addressed herein.

Claim 26, and its dependent claim 27, recite at least one capillary communicating from the outer surface of the cover layer to the core. As amended, claim 26 characterizes the at least one capillary as communicating through the cover layer. The at least one capillary in the cover layer is characterized as having a material filling at least a part thereof with a material that is different than the material defining the cover layer.

The Examiner states that the presence of a capillary is moot since the capillary may be completely filled. Applicant respectfully disagrees with the Examiner's position. The existence of a material in a capillary that is different than the material through which the capillary extends does not eliminate the existence of the capillary.

Yoshida does not teach or suggest any corresponding capillary. Accordingly, claims 26 and 27 are believed to be allowable.

This application is related to continuation-in-part application Serial No. 10/025,396 which was discussed at the interview together with this case. It is respectfully suggested that the Examiner may wish to consider both applications together since the subject matter is closely related.

The Examiner also indicated that she should contact the undersigned if there were additional questions relating to the patentability of the pending claims.

Reconsideration of the rejection of claims 1 through 17, 19, 26, and 27, and allowance of the case are requested.

Respectfully submitted,

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